

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS & AMENDMENTS

Claims 1-9 were pending in this application when last examined.

Claims 1-4 were examined on the merits and stand rejected.

Claims 5-9 were withdrawn as non-elected subject matter.

Claim is amended to better conform with US practice for method by revising the claim into “comprising” format and then listing the separate method steps thereafter. Claim 1 is also amended to incorporate the subject matter of claim 4. Further support can be found in the disclosure, at page 4, lines 16-29, and in the description from page 6, line 6 to page 13, line 31, Experimental Example 1, Experimental Example 2 and Figure 2 (page 22, lines 21-28 and page 23, lines 1-2), and in original claims 1 and 4.

Claims 1-3 are amended to replace “yeast cell” with “yeast cells” as supported by the disclosure and the working Examples, see for instance, page 22.

Claim 3 is amended to replace “mashing” with “cells are ruptured by mashing” to be consistent and recite proper antecedent basis with claim 1, which recites “rupturing.”

New claims 10-12 have been added.

Support for new claim 10 can be found in the disclosure, for example, at page 12, lines 17-18, page 13, lines 4-10 and page 14, line 21.

Support for new claim 11 can be found in the disclosure, for example, at page 7, lines 21-23.

Support for new claim 12 can be found in the disclosure, for example, at page 13, line 24 and page 26, lines 7-8.

No new matter has been added.

Claims 4-9 are cancelled without prejudice or disclaimer thereto. Applicants reserve the right to file a continuation or divisional application on any cancelled subject matter.

Claims 1-3 and 10-12 are pending upon entry of this amendment.

II. OBJECTION TO THE SPECIFICATION

In item 4 on page 3 of the Action, the Specification was objected to for lacking a reference to the foreign priority data to Japanese Patent Application No. 001317/2004, filed January 2003. It was indicated that the Specification at page 1 should be amended to make such a reference.

This objection is respectfully traversed.

Such amendment is not required under 37 C.F.R. § 1.78 or M.P.E.P. § 201.11. The instant application was filed under 37 CFR 1.53(b) (*i.e.*, it is not a 371 National Stage application) and there is no intervening PCT application. Accordingly, neither the statute or the rules require such an amendment for the instant application (which was filed under 37 CFR 1.53(b) and there is no intervening PCT application). For this reason, the objection to the Specification is untenable should be withdrawn.

III. FOREIGN PRIORITY

Kindly acknowledge the foreign priority claim under 35 U.S.C. § 119(a)-(d) or (f) and receipt of the certified copy of the foreign priority document. A certified copy was submitted with the filing of the instant application as noted in the "Claim of Priority Under 35 U.S.C. § 119" document submitted January 7, 2004.

IV. ANTICIPATION REJECTION

In item 6 on pages 2-3 of the Action, claims 1-4 were rejected under 35 U.S.C. § 102(b) as anticipated by Schultz (Methods: A Comparison to Methods in Enzymology, Vol. 17, pp. 161-172, 1999), as cited in the IDS of May 3, 2004.

This rejection is respectfully traversed as applied to the amended and new claims.

To anticipate a claim, a cited prior art reference must teach each and every element of the claimed invention. M.P.E.P. § 2131.01.

Amended claim 1 calls for a method for preparing a yeast extract solution for cell-free protein synthesis, said method comprising:

freezing yeast cells to obtain frozen yeast cells;

rupturing said frozen yeast cells to obtain ruptured frozen yeast cells;

extracting said ruptured frozen yeast cells with a buffered solution for extraction to obtain an extract solution; and

after said extraction, removing intracellular components having a molecular weight of not more than 5,000 from said extract solution and concentrating the resulting solution to obtain the yeast extract solution capable of cell-free protein synthesis.

It is respectfully submitted that Schultz fails to disclose or suggest each and every element of the present invention. Specifically, Schultz fails to disclose or suggest the steps of removing intracellular components having a molecular weight of not more than 5,000 from said extract solution and concentrating the resulting solution to obtain the yeast extract solution capable of cell-free protein synthesis.

The effect of the concentration step is described in Experimental Example 1, Experimental Example 2 and Figure 2 of the disclosure.

In Experimental Example 1 of the Specification, the extract solution obtained in Example 1 is used. Namely, as described on page 22, lines 21-28, after extraction, the extract solution is

centrifuged and subject to gel filtration by means of PD-10. Thus, the obtained extract solution is not concentrated and has an absorbance of 25 at 280 nm (page 23, lines 1-2).

By contrast, Experimental Example 2 describes concentrating the extract solution of Example. The concentrated extract solutions in Experimental Example 2 have an absorbance of 22, 37, 50, 62 and 74 at 280nm.

The amount of luciferase synthesized from the extract solution is shown in Figure 2. As shown therein, the concentrated extract solutions have high synthesis ability. In fact, the concentrated extract solutions having an absorbance of 37, 50, 62 and 74 at 280 nm (*i.e.*, the absorbance within the range of new claim 12) have much higher synthesis ability.

Schultz fails to disclose or suggest this concentrating step of the present invention. For this reason, Schultz does not anticipate the present invention.

Therefore, the 102(b) anticipation rejection of claims 1-4 over Schultz is untenable and should be withdrawn.

V. INDEFINITENESS REJECTION

In item 9 on pages 3-4 of the Action, claims 1- 4 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite for the recitation “extract” for the reasons set forth.

This rejection is respectfully traversed as applied to the amended and new claims.

The Office has taken the position that the “extract” in claim 1 is vague and indefinite, because it does not adequately delineate the metes and bounds of the claim. The Office has taken the position that this term should be described as a product-by-process claim.

In reply thereto, kindly note the claims are directed to a method for preparing a yeast extract solution, as opposed to the yeast extract solution itself. The claims clearly recite the method steps for making the extract. Specifically, the claims call for rupturing a yeast cell in a frozen state and obtaining an extract solution thereof. The recited method steps involve using conventional and well known techniques and procedures as disclosed in the Specification. As

such, the term "extract" is already defined by the recited steps in the process of making it. Moreover, one skilled in the art, upon reading the disclosure and in view of the knowledge in the art, would clearly understand metes and bounds of the recited method steps. For these reasons, the claims are not vague and indefinite. Therefore, it would be duplicative and unnecessary to amend the claims to define the term "extract" as a product-by-process.

It is well established that the definiteness of claim language is determined, not in a vacuum, but taking into consideration the teachings of the Specification and the knowledge in the art. Furthermore, it is well established that breadth of a claim is not to be equated with indefiniteness, so long as the scope of the subject matter embraced by the claims is clear. See See M.P.E.P. § 2173.04.

In this case, one skilled in the art would understand the metes and bounds of the recited process steps involved in the claimed method for making the yeast extract solution.

Thus, the indefiniteness rejection of claims 1-4 is untenable and should be withdrawn.

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CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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